

Application No. 09/720,770
Paper Dated July 29, 2004
In Reply to USPTO Correspondence Dated January 30, 2004
Attorney Docket No. 702-001869

REMARKS

The Office Action of January 30, 2004 has been reviewed and the Examiner's comments carefully considered. The present Amendment amends claims 30, 35, 36, 39, 41, 43, 44, 46-50 and 54 and adds new claim 56 in accordance with the originally-filed specification. No new matter has been added. Claims 30-56 remain in this application.

Initially, claim 30 stands rejected under 35 U.S.C. § 101 as reciting a single means. Specifically, the Examiner believes that, where a means recitation does not appear in combination with another recited element of means, it is subject to an undue breadth rejection. Applicant has reviewed independent claim 30, which was formerly directed to a method "for addressing a person or organization via electronic means." In accordance with the Examiner's suggestions, independent claim 30 has been modified in an appropriate manner to read as a method claim, including the necessary steps to carry out the claimed invention. Therefore, in view of the amendment to independent claim 30, Applicant respectfully requests reconsideration of this rejection.

Next, the Examiner has rejected all of claims 30, 35, 36, 39, 41, 43, 44, 46-50 and 54 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. In particular, the Examiner has rejected these claims for insufficient antecedent basis and the improper use of pronouns. All of claims 30, 35, 36, 38, 39, 41, 43, 44, 46-50 and 54 have been appropriately modified to correct the claims in view of these comments. Accordingly, in view

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of these amendments, Applicant respectfully requests reconsideration of these rejections.

Claims 30-33, 39, 40, 46 and 47 stand rejected under 35 U.S.C. § 102(e) as being anticipated by WO 99 40527 A to Benjamin et al. (hereinafter "the Benjamin reference"). Claims 34-38, 54 and 55 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Benjamin reference in view of European Patent Application No. 0 375 138 A2 to Kasiraj et al. (hereinafter "the Kasiraj reference"). Finally, claims 34-38, 41-45 and 48-53 stand rejected under 35 U.S.C. § 103(a) as being obvious over the Benjamin reference in view of WO 99331882 A2 to Paul (hereinafter "the Paul reference"). In view of the above amendments and the following remarks, Applicant respectfully requests reconsideration of these rejections.

Independent claim 30 of the present application, as amended, is directed to a method for addressing a person and/or an organization via electronic means and for sending, in an electronic manner, one or more e-mail messages addressed accordingly. The method includes the steps of: storing addresses of the people and organizations in a database; linking the addresses from the database to publicly accessible data held by an organization; automatically retrieving an e-mail address in addressing data in the database; and sending at least a part of the message to the e-mail address retrieved by searching the publicly accessible data. As an example of publicly accessible data held by an organization, such data may include a social security number, a D&B DUNS number, a chamber of commerce number, *and* a VAT number, ~~and~~

The Benjamin reference is directed to a system for handling electronic mail. In particular, the method includes conveying an e-mail message including an address field in which

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Application No. 09/720,770
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an account name portion of the address field is a descriptor of the intended recipient of the message, and which may be different from the account name of the intended recipient. This information is then located in the database of descriptors and e-mail addresses, and the message is transmitted to the e-mail address yielded by the database. The database may include fields corresponding to commonly-used identifiers, such as telephone number, business name, street address or personal name. In addition, the database 4 may be located in multiple sites and distributed over various locations. See page 10, lines 21-28 of the Benjamin reference.

The Kasiraj reference is directed to the restriction of electronic message traffic. The Examiner appears to be using the Kasiraj reference for its discussion of the filtering of e-mail messages for viruses, spam or transmission permissions and the like. The method and system of the Kasiraj reference provides the restriction of delivery and receipt of electronic messages. See column 2, lines 6-35 of the Kasiraj reference. The Examiner also appears to use the Kasiraj reference for its discussion of providing secure message traffic.

The Paul reference is directed to an apparatus and method for controlling delivery of unsolicited electronic mail. Like the Kasiraj reference, it appears that the Examiner is using the Paul reference for its discussion of filtering mechanisms and systems for controlling the delivery of unsolicited e-mail messages. For example, see page 2, line 5-page 4, line 15 of the Paul reference. In addition, it appears that the Examiner is using the Paul reference for its disclosure of registering users by means of user profiles and including exclusion and/or permission lists.

As discussed above, independent claim 30 has been modified to further elucidate the novel nature of the invention of the present application. In particular, after storing addresses of the people and organizations in a database, the method includes linking the addresses from the database to publicly accessible data held by an organization. Such data held by an organization is searched according to a specific protocol, such as a social security number, a D&B DUNS number, a chamber of commerce number, a VAT number, etc. The advantage of linking the addresses from the database to such publicly accessible data held by an organization is that a sender that is in possession of a database comprising a large number of such identifications can send a large mailing automatically to all persons or business identifiable by means of their entry in this publicly accessible database, or a subset thereof.

Such a method and system is clearly different than the method and system set forth in the Benjamin reference. Instead, the Benjamin reference describes a system that is directed at sending e-mail by individuals making use of descriptors, such as a telephone number for sending an e-mail to another individual. Unlike the system of the Benjamin patent, and as specifically set forth in independent claim 30 of the present application, as amended, the present invention uses publicly accessible data held by an organization. An organization such as the social security service provider or chamber of commerce, is capable of sending out a mailing to a large group of their "clients" making use of their own database for doing so. Such availability and linking creates the beneficial effect of the organization sending out the mailing without having to retrieve all individual e-mail addresses of the recipients. Such a system is very

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different from the Benjamin system for handling electronic mail, in which the e-mail can be sent to a server without knowing an e-mail address that can link a general descriptor, such as a telephone number, which is individually entered to an e-mail address.

With respect to the Kasiraj reference, this document is directed to a system that assesses whether recipients fall under a delivery restriction. Accordingly, the delivery of e-mail to such a recipient is dependent upon the "status" of the recipient. Although this is a form of filtering, this method of filtering is substantially the opposite of the spam filtering discussed in the present application. In particular, the spam filtering functionality discussed in the present application is based upon a recipient's wish not to receive unsolicited mail, and is not based upon the recipient's authorization to receive classified e-mail. Therefore, Kasiraj is directed to preventing recipients from receiving mail that they are not authorized to read. Regarding the Paul reference, this system is directed to a spam-preventing system and does not comprise a filter based upon the source data of spam. However, neither the Kasiraj reference nor the Paul reference describes a method for addressing a person and/or an organization via electronic means and for sending, in an electronic manner, one or more e-mail messages addressed accordingly, as set forth in independent claim 30, as amended, of the present application. Further, the Examiner has not used the Kasiraj reference or the Paul reference as a basis for the rejection of independent claim 30.

It is noted that the Examiner has used the Kasiraj reference and/or the Paul reference to cure the deficiencies of the Benjamin reference by demonstrating the combination

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of these disclosures. As set forth in MPEP § 2143.03, to establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. Further, the Examiner cannot use the claims as a blueprint for locating separate claim elements in separate prior art references without considering the teachings of the prior art as a whole and without considering the complete teachings of the separate references. There is nothing in the Kasiraj reference and the Paul reference which suggests the desirability of combining these teachings with the Benjamin reference. In addition, and as discussed above, these references do not address the spam prevention portion of the present invention as contemplated in the present application. Further, there is no incentive to combine these references together in order to arrive at the claimed subject matter of the present application. In the absence of some “clear and particular” motivation to combine the teachings of the cited prior art, the rejection is improper. Winner Int’l Royalty Corp. v Wang, 202 F.3d 1340, 1348-49 (Fed. Cir. 2000).

For the foregoing reasons, independent claim 30 is not anticipated by or rendered obvious over the Benjamin reference, the Kasiraj reference, the Paul reference and any of the other prior art of record, whether used alone or in combination. There is no hint or suggestion in any of the references cited by the Examiner to combine these references in a manner which would render the invention, as claimed, obvious. Reconsideration of the rejection of independent claim 30 is respectfully requested.

Claims 31-56 depend either directly or indirectly from and add further limitations to independent claim 30 and are believed to be allowable for the reasons discussed hereinabove

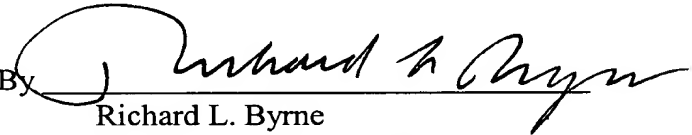
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in connection with independent claim 30. Therefore, for all of the above reasons, reconsideration of the rejections of claims 31-55 is respectfully requested.

For all the foregoing reasons, Applicant believes that claims 30-56, as amended and added, are patentable over the cited prior art and in condition for allowance. Reconsideration of the rejections and allowance of all pending claims 30-56 are respectfully requested.

Respectfully submitted,

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